

REMARKS

I. Status of the claims

By this Amendment, Applicants amend claims 13 and 60 to cure a minor informality and add new claims 87-91. Claims 1-91 are therefore pending in this application.

In the Office Action of March 22, 2005:¹

- (1) Claims 7-12 and 14-16 were objected to for being multiply dependent under 35 C.F.R. § 1.75(c);
- (2) Claim 60 was objected to for a minor informality;
- (3) Claim 70 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;
- (4) Claims 1-6 and 36-41 were rejected under 35 U.S.C. § 103(a) as anticipated by U.S. Patent Application Publication No. 2002/0035611 ("*Dooley*") in view of U.S. Patent No. 6,719,565 to *Saita et al.* ("*Saita*");
- (5) Claims 21-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0024528 ("*Lambertsen*") in view of U.S. Patent Application Publication No. 2003/0061202 ("*Coleman*") in further view of U.S. Patent Application Publication No. 2002/0019763 ("*Linden*");
- (6) Claims 24-27, 56-59 and 61-69 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Linden*;
- (7) Claims 28-35, 70-79 and 81-86 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Linden* in further view of *Lambertsen*;
- (8) Claims 13, 42-44 and 47-51 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Saita* in further view of *Coleman*;
- (9) Claims 45 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Saita* in view of *Coleman* and in further view of *Lambertsen*;
- (10) Claims 17-19 and 52-54 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view *Saita* in further view of *Lambertsen*;

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

- (11) Claims 20 and 55 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Saita* in view of *Lambertsen* and in further view of *Coleman*;
- (12) Claim 60 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Linden* in further view of *Dooley*; and
- (13) Claim 80 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Linden* in view of *Lambertsen* in further view of European Patent Application Publication No. 0226959A2 ("*Horikita*") and in further view of U.S. Patent No. 6,707,929 to *Marapane et al.* ("*Marapane*").

Applicants address the objections and rejections, as well as the new claims, below.

II. Regarding the nature of the rejections

The Office Action states that claims 1-6 and 36-41 are rejected under "35 U.S.C. 102(e)" based on *Dooley* and *Saita*. Office Action ("OA") at 3. The Office Action also states that claims 24-27, 56-59, and 61-69 are rejected under "35 U.S.C. 102(e)" based on *Coleman* and *Linden*. OA at 11. Although the rejection statements for these claims indicate that the claims are rejected under § 102(e), the substance of the rejections reflect that the claims are rejected under § 103(a). Applicants thus address the rejection of claims 1-6 and 36-41 and the rejection of claims 24-27, 56-59, and 61-69 as § 103(a) rejections. Should the Examiner continue to dispute the patentability of these pending claims, Applicants request clarification in the next Office Action of the appropriate bases of rejection.

III. Regarding the Response to Applicants' Amendment Remarks

In various portions of the Office Action (*see* pages 49-60), the Examiner states that the "examiner agrees" that certain cited references "meet each and every limitation of the applicant's [claimed] invention." To the extent the Examiner is alleging that Applicants have somehow "agreed" that the cited art teaches or suggests various features of Applicants' claims, Applicants expressly traverse such an allegation. Applicants have not "agreed" that any of the cited

references, or any combination thereof, meets each and every feature of any currently pending claim.

IV. Objection to claims 7-12 and 14-16

The Examiner objected to claims 7-12 and 14-16 “for being multiply dependent under 37 C.F.R § 1.75(c).” OA at 48. Applicants disagree with this objection. Contrary to the Examiner’s position, claims 7-12 and 14-16 are proper. As explained in the Amendment filed December 6, 2004, none of claims 7-12 and 14-16 is a multiple dependent claim. Further, claim 3, upon which claims 7 and 12 depend, is a proper multiple dependent claim that refers to claims 1 and 2 in the alternative. (See M.P.E.P. § 608.01(n).) Applicants therefore request withdrawal of the objection to claims 7-12 and 14-16 under 37 C.F.R § 1.75(c).

V. Objection to claim 60

Claim 60 was objected to for a minor informality. Specifically, the Examiner noted that the phrase “using based” should instead read --using is based--. OA at 48. Applicants have amended claim 60 to address the informality noted in the Office Action. Applicants respectfully request that the objection be withdrawn.

VI. Rejection of claim 70 under 35 U.S.C. § 101

The Office Action alleged that claim 70 is directed to non-statutory subject matter because the “language of the claims (e.g., ‘beauty product’, ‘simulation’, ‘query’) . . . [raises] a question as to whether the [claim is] . . . directed merely to an abstract idea . . . not tied to a technological art, environment or machine” OA at 2. Applicants respectfully disagree with the § 101 rejection because claim 70 is non-abstract and statutory.

Initially, Applicants point out that the Office Action does not establish a *prima facie* showing that claim 70 is an abstract idea not tied to a technological art. The conjectural

allegation that certain claims terms “raise a question” as to whether the claim is abstract is wholly unsupported and does not by itself establish that the claim is abstract or not within the technological arts. Because no evidence has been provided to support the allegations in the Office Action, the rejection of claim 70 under 35 U.S.C. § 101 should be withdrawn. The lack of a *prima facie* showing notwithstanding, Applicants submit that claim 70 is non-abstract and within the technological arts, as discussed below.

In rejecting claim 70, the Examiner alleged that “if claim 70 were amended to recite a computer-implemented method and required performance of a result outside of a computer, it will be statutory in most cases” OA at 3. To the extent the Examiner is alleging that claim 70 is non-statutory because it does not recite computer-related features, such an allegation is not supported by proper authority in the Office Action. In fact, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999) (emphasis added), 50 USPQ2d 1447, 1452-1453. Applicants submit that claim 70 is non-abstract and tied to the useful or “technological” arts, regardless of whether it specifically recites physical structure or computer-related limitations.

Moreover, according to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375; 47 USPQ2d (BNA) 1596, 1602 (Fed. Cir. 1998). If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*,

149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358, 50 USPQ2d at 1451-52. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

Claim 70 includes recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application and are not abstract. For example, “enabling a display of a simulation of the first beauty product applied on a facial image” produces concrete, tangible, and useful results that facilitate, for example, a complimentary beauty product recommendation. For at least the foregoing reasons, the rejection of claim 70 under 35 U.S.C. § 101 should be withdrawn.

VII. Section 103(a) rejection of claims 1-6 and 36-41

Applicants traverse the rejection of claims 1-6 and 36-41 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Dooley* in view of *Saita*. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claim 1, as currently presented, recites a combination including:

accessing a data structure containing information reflecting
relationships between categories of user-specific information and

beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice; [and]
...

identifying, using the artificial intelligence engine, beauty advice determined by the artificial intelligence engine to be related to the user-specific information.

Neither *Dooley* nor *Saita*, nor any combination thereof, teaches or suggests at least the above-noted features, for the reasons presented below.

Dooley is directed to an Internet-based information network (Abstract). In particular, *Dooley* describes a network of linked websites related to a particular field that increases the network owner's web presence (and search engine ranking) and reduces the need for conventional advertising. As affirmed by the Examiner, *Dooley* fails to teach "information reflecting relationships derived from at least one of consumer preferences and expert advice." OA at 5. For at least this reason, *Dooley* does not teach or suggest the claimed "accessing."

Additionally, contrary to the Examiner's position, *Dooley* does not disclose "accessing a data structure containing information reflecting relationships between categories of user-specific information and beauty advice" as recited in claim 1. The Office Action notes *Dooley*'s disclosure of a "lexicon" of categorized domain names that can include medical professionals (e.g., beauty-consultants.net) and can be deployed as websites. OA at 4; *Dooley*, page 3, ¶¶ 31-32, pages 7-8, ¶ 70. The Office Action also notes *Dooley*'s disclosure of system websites and entry websites (page 4, ¶ 39) and that placement within search engine results may be affected by various web design elements (page 5-6, ¶ 56). These disclosures do not support the allegation that *Dooley* discloses the claimed "accessing." A lexicon of categorized domain names does not constitute a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, and, furthermore, *Dooley* does not even disclose

accessing the lexicon. In addition, neither networking system and entry websites nor affecting search engine results using design elements constitutes the claimed “accessing.”

The Office Action notes (OA at 4) *Dooley*’s disclosure of obtaining identifying and registration information (page 6, ¶ 57). Even if such identifying and registration information were consistent with the claimed “user-specific information,” *Dooley* does not teach or suggest accessing a data structure containing information reflecting relationships between categories of identifying/registration information and beauty advice. Moreover, although *Dooley* discloses website content, it does not disclose that such content includes beauty advice. Even if *Dooley*’s websites were to include beauty advice, *Dooley* does not disclose or suggest accessing a data structure containing information reflecting relationships between categories of user-specific information and those websites. For at least these reasons, *Dooley* fails to teach or suggest the claimed “accessing.”

The Examiner notes that Applicants’ specification² states that a “data structure” may include any “mechanism capable of containing information.” OA at 45. The Examiner also notes that the specification states that user-specific information “is not necessarily related to any particular user.” OA at 46. These descriptions in the specification³ do not alter *Dooley*’s application to claim 1. *Dooley* does not teach or suggest accessing any component or mechanism containing information reflecting relationships between categories of user-specific information, related to a particular user or not, and beauty advice.

² Applicants remind the Examiner that “[w]hile the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination . . . the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. M.P.E.P. § 2111.01 (internal citations omitted).

³ In referring to the Specification, Applicants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Dooley also fails to disclose the “identifying” recited in claim 1. The Office Action notes *Dooley*’s disclosure of creating a “lexicon” of categorized domain names that can include medical professionals (e.g., beauty-consultants.net) and that can be deployed as websites (page 3, ¶¶ 31-32; pages 7-8, ¶ 70). The Office Action also notes *Dooley*’s disclosure of obtaining identifying/registration information from a user (page 6, ¶ 57). Contrary to the Examiner’s position, neither mining available domain names nor creating a lexicon of categorized domain names is consistent with identifying, using an artificial intelligence engine, beauty advice determined to be related to the user-specific information, as claimed. In addition, neither obtaining search results nor obtaining identifying/registration information constitutes the claimed “identifying.”

To the extent the Examiner is alleging that *Dooley*’s websites include beauty advice, such an allegation is not properly supported. *Dooley* does not disclose that websites associated with the domain names include “beauty advice.” In fact, *Dooley* discloses that the domain names (e.g., beauty-consultants.net) may be deployed as websites with minimal content or even as active domain names without associated websites (page 4, ¶ 40). The fact that a domain name in *Dooley*’s information network might be “beauty-consultants.net” does not in and of itself evidence that the site provides “beauty advice.” According to *Dooley*, such a site may serve only to increase a network owner’s web presence or search engine rating. Even if the websites were construed as including beauty advice, *Dooley* does not disclose identifying, using an artificial intelligence engine, such beauty advice determined by the artificial intelligence engine to be related to user-specific information. Indeed, *Dooley* merely describes a network of websites related to a field that increases the network owner’s web presence. In addition, although *Dooley*

mentions “artificial intelligence software,” it merely mentions that such software can customize a user’s session and assist routing the user through the network of websites.

The Examiner notes that Applicants’ specification⁴ states that artificial intelligence describes “any computationally intelligent systems that combine knowledge, techniques, and methodologies.” OA at 45. This description does not serve to cure *Dooley*’s deficiencies. That is, *Dooley* does not disclose identifying, using any computationally intelligent system, such beauty advice determined by the any computationally intelligent system to be related to user-specific information. For at least the foregoing reasons, *Dooley* does not teach the claimed “accessing” or “identifying.”

Saita does not cure *Dooley*’s deficiencies. *Saita* describes a hair color advice system (Abstract, Title). In *Saita*’s system, a “subject’s image data is input into [a] . . . personal computer 1.” Col. 3, lines 1-17. In addition, as the Examiner notes, “an array of simulated images in which the subject’s hair is dyed to various representative colors are . . . displayed” and the subject can “indicate the desired hair color from among the simulated images.” Col. 4, lines 54-60. *Saita* discloses that the various preference information from the subject “may be input to the computer 1 . . . so that this information is reflected when the dye corresponding to the desired hair color is subsequently output.” Col. 4, lines 59-67.

Contrary to the Examiner’s allegations, the above-noted disclosures in *Saita* do not teach or suggest “accessing a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice,” as recited in claim 1. Although *Saita* mentions subject preferences, the reference does not teach or suggest

accessing a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, where the information reflecting relationships is derived from those subject preferences or expert advice.

Furthermore, *Saita* does not teach or suggest the claimed “identifying, using the artificial intelligence engine, beauty advice determined by the artificial intelligence engine to be related to the user-specific information,” as recited in claim 1.

Accordingly, neither *Dooley* nor *Saita*, nor any combination thereof, teaches or suggests each and every element recited in claim 1. As such, *prima facie* obviousness has not been established and the § 103(a) rejection of claim 1 should be withdrawn.

Moreover, regardless of whether all of the features of claim 1 could be found in some combination of *Dooley* and *Saita*, *prima facie* obviousness has not been established at least because the requisite motivation to combine the references is lacking. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

(...continued)

⁴ See footnote 3.

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Dooley* and *Saita*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Dooley* in view of *Saita* in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified *Dooley* “for the purpose of creating a simulated image of the subject.” OA at 5. This conclusory allegation in the Office Action is not properly supported and does not establish a motivation or suggestion for modifying *Dooley*. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not establish why, other than to attempt to meet the terms of Applicants’ claim, a skilled artisan would have modified *Dooley* as alleged.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Dooley* and *Saita* disclose certain elements, without showing reasons that a skilled artisan would select or modify

those elements in the manner claimed and also without showing that the claimed invention as a whole would have been obvious. For example, even if *Dooley* were to disclose “accessing a data structure containing information reflecting relationships between categories of user-specific information and beauty advice,” and if *Saita* were to disclose “the information reflecting relationships derived from at least one of consumer preferences and expert advice” (Applicants disputing those contentions), the Office Action does not show that a skilled artisan would have selected those elements to achieve Applicants’ claimed invention as a whole including the claimed “accessing” feature. The conjectural conclusions set forth in the Office Action do not suffice to establish a *prima facie* conclusion of obviousness. Furthermore, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For at least these additional reasons, a *prima facie* case of obviousness has not been established with respect to claim 1.

Because *prima facie* obviousness has not been established, the § 103(a) rejection of claim 1 should be withdrawn. The § 103(a) rejection of dependent claims 2-6 should be withdrawn as well, for at least reasons similar to those presented above in connection with claim 1. Applicants therefore request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 1-6.

Independent claim 36 recites a combination including:

a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice; [and]

an artificial intelligence engine, configured to receive and process the information reflecting relationships and user-specific information, to thereby identify beauty advice determined by the

artificial intelligence engine to be related to the user-specific information.

Although claim 36 is of different scope than claim 1, *prima facie* obviousness has not been established with respect to claim 36 for reasons similar to those presented above in connection with claim 1. Because *prima facie* obviousness has not been established, the rejection of claim 36 under 35 U.S.C. § 103(a) should be withdrawn. In addition, the § 103(a) rejection of claims 37-41, which depend upon claim 36, should be withdrawn, for at least reasons similar to those presented above in connection with claim 36. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 36-41.

VIII. Section 103(a) rejection of claims 21-23

Applicants traverse the rejection of claims 21-23 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Lambertsen*, *Coleman*, and *Linden*.

Independent claim 21, as currently presented, recites a combination including:

maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products . . . [and]

processing, using the artificial intelligence engine, information characterizing the at least two selected beauty products and suitability of use information to thereby identify at least one additional product, complementary to a combination of the at least two selected products.

As affirmed by the Examiner, *Lambertsen* fails to disclose the “processing” feature of claim 21.

OA at 10.

Additionally, *Lambertsen* fails to teach or suggest at least “maintaining information about suitability,” as claimed. The Office Action notes *Lambertsen*’s disclosure of a product catalog and palette database. OA at 10; *Lambertsen*, page 1, ¶ 8. According to *Lambertsen*, the product

catalog “includes a variety of beauty products” and a palette refers to a “complete makeover, consisting of a collection of beauty products, which can ‘applied’ instantly to an image on the computer screen, together with . . . instructions implementing the manner, location, and form in which they are to be applied” (page 1, ¶ 8). Contrary to the Examiner’s position, a catalog of a variety of beauty products does not teach or suggest information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products. Further, a collection of beauty products that create a makeover does not teach or suggest information about suitability of use of at least some beauty products with other beauty products. Although *Lambertsen*’s palettes include products that may be suitable for use together, *Lambertsen* does not disclose maintaining information about the suitability of using products. *Lambertsen* merely discloses that the palettes are pre-configured or created by a user from a list of available products (page 3, ¶ 29). It does not disclose, for example, that the palettes are created based on information about the suitability of using products. For at least these reasons, *Lambertsen* does not teach or suggest “maintaining information about suitability,” as claimed.

Linden does not cure *Lambertsen*’s deficiencies. *Linden* is directed to “monitoring user browsing activities . . . and using such information to identify items that are related to one another” (Abstract). As the Examiner notes, *Linden* discloses “identifying items that tend to be viewed in combination” (page 2, ¶ 15). *Linden* also mentions identifying relationships between items that are “pure substitutes” and “purchase based relationships . . . between items that are complements of one another (tend to be bought in combination)” (page 2, ¶ 15). Additionally, *Linden* mentions that “item-to-item mappings could reflect . . . content-based similarities” (page 4, ¶ 52).

Although *Linden* discloses identifying relationships between items, the reference does not disclose “maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products,” as recited in claim 21.

Information identifying items as “pure substitutes” does not constitute information about the suitability of using some beauty products with other beauty products. In addition, *Linden*’s information regarding “complements” does not constitute the claimed “suitability” information.

As explained above, *Linden*’s “complements” are merely items that “tend to be bought in combination.” *Linden* does not disclose maintaining information about the suitability of using some products with other products. That is, while *Linden* mentions identifying that certain products are bought in combination, the reference does not disclose maintaining information regarding the suitability of the combination. That items are bought together is not reflective of the suitability of combining those items. Moreover, *Linden*’s information reflecting “content-based similarities” does not constitute the claimed “suitability” information. Information about product similarities is not the same as information about the suitability of combining products. For example, similar items may or may not be suitable for combination. For at least these reasons, *Linden* does not teach or suggest the claimed “maintaining information about suitability.”

In addition, *Linden* does not teach or suggest the claimed “processing.” Although *Linden* mentions identifying items that tend to be bought in combination, the reference does not teach or suggest “processing, using the artificial intelligence engine, information characterizing the at least two selected beauty products and suitability of use information to thereby identify at least one additional product, complementary to a combination of the at least two selected products.” As explained above, *Linden* does not disclose or suggest the claimed “suitability” information

and thus does not disclose or suggest identifying one or more complementary products by processing such suitability information. Further, *Linden* does not disclose that items are identified by processing “information characterizing the at least two selected beauty products,” as claimed. Indeed, *Linden* merely mentions identifying related items using a table, which is based on relationships determined using browsing data. Also, *Linden*’s system merely identifies items related to a particular item of interest. The reference does not teach or suggest identifying at least one additional product that is “complementary to a combination of the at least two selected products,” as claimed.

Coleman does not cure the deficiencies of *Lambertsen* and *Linden*. *Coleman* is directed to using “a fuzzy logic engine (FLE) for an interactive product selector” (Abstract). Specifically, *Coleman* describes a FLE that can “evaluate . . . user requirements against available products or services to generate product or service recommendations most closely matching the user requirements” (page 6; ¶ 57). In *Coleman*’s system, a user selects a category of goods or services (FIG. 8; page 9, ¶ 81). A product criteria is then generated in response to the selection (FIG. 8; page 9, ¶ 82). The user specifies options for the criteria, and a product set is assembled by sorting a preprocessed set of products according to the user-specified options (FIGS. 8, 9; pages 10-11).

Coleman does not disclose “maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products.” *Coleman* also fails to teach or suggest the claimed “processing.” *Coleman* merely mentions identifying products by measuring user requirements and changes in those requirements. *Coleman*’s disclosure of presenting users with feature selections and allowing users to view a generated product set does not teach or suggest “processing, using [an] artificial intelligence

engine, information characterizing . . . selected beauty products and suitability of use information to thereby identify at least one additional product, complementary to a combination of . . . the selected products,” as recited in claim 21. Further, allowing users to compare products, as mentioned by *Coleman* (page 6, ¶ 52), does not teach or suggest the claimed “processing.” Indeed, *Coleman* does not disclose the “processing” recited in claim 21.

Accordingly, neither *Lambertsen*, *Linden*, nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature of claim 21. As such, *prima facie* obviousness has not been established and the § 103(a) rejection of claim 21 should be withdrawn.

Moreover, even if all of the features of claim 21 could be found in some combination of *Lambertsen*, *Linden*, and *Coleman*, *prima facie* obviousness has not been established at least because the requisite motivation to modify *Lambertsen* in view of *Linden* and *Coleman* is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan considering the cited art, and not having the benefit of Applicants’ disclosure, would have been motivated to combine or modify those references in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified *Lambertsen* “for the purpose of providing valuable guidance to the user and determining product relatedness.” OA at 11. This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Lambertsen* as alleged. The Office Action does not establish that a skilled artisan would select or modify the various elements allegedly disclosed by the cited art in the manner claimed and does not establish that Applicants’ claimed invention as a whole would have been obvious. Applicants further submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 21 and the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn. The § 103(a) rejection of claims 22 and 23 should be withdrawn as well, at least because those claims depend upon base claim 21. Applicants thus request withdrawal of the rejection of claims 21-23 under 35 U.S.C. § 103(a) and the timely allowance of those claims.

IX. Section 103(a) rejection of claims 24-27, 56-59 and 61-69

Applicants traverse the rejection of claims 24-27, 56-59 and 61-69 under 35 U.S.C. § 103(a) because *prima facie* obviousness has not been established based on *Coleman* and *Linden*.

With regard to independent claim 24, the Examiner conceded that *Coleman* does not teach or suggest “identifying, by the artificial intelligence engine, at least one recommended product complementary to the at least one user-specified product using at least the information about product relationships.” In an attempt to establish *prima facie* obviousness, the Examiner cites *Linden* as allegedly curing *Coleman*’s deficiencies. Regardless of whether or not *Linden* discloses the features missing from *Coleman*, a case for *prima facie* obviousness has not been established at least because the requisite motivation to modify the references is lacking.

As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” Additionally, Applicants again call attention to M.P.E.P. § 2141.02, which states: “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). Applicants again note that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998).

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Coleman* and *Linden*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Coleman* in view of *Linden* in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified *Dooley* “for the purpose of determining product relatedness.” OA at 13. This conclusory allegation in the Office Action is not properly supported and does not establish a motivation or suggestion for modifying *Coleman*. For example, the Examiner provides no evidence or reasoning to show how the alleged modification would in fact achieve the alleged result, or to show that a skilled artisan would even be concerned with achieving that result. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show why, other than to attempt to meet the terms of Applicants’ claim, a skilled artisan would have modified *Coleman* as alleged.

Indeed, while alleging that *Coleman* and *Linden* disclose certain elements, the Office Action does not establish that a skilled artisan would select or modify those elements in the manner claimed and does not establish that Applicants’ claimed invention as a whole would have been obvious. For example, even if *Linden* were to disclose identifying at least one product “complementary to the at least one user-specified product using at least the information about product relationships,” the Office Action does not show that a skilled artisan would have selected those elements to achieve Applicants’ claimed invention as a whole. The conjectural conclusions set forth in the Office Action do not suffice to establish a *prima facie* conclusion of obviousness. Furthermore, Applicants submit that the conclusions in the Office Action were not

reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

Because the requisite motivation to modify is lacking, a *prima facie* case of obviousness has not been established with respect to claim 24 and the § 103(a) rejection of that claim should be withdrawn. Likewise, the § 103(a) rejection of dependent claims 25-27 should be withdrawn, for at least reasons similar to those presented above in connection with claim 24. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 24-27.

Independent claim 56 recites a combination including:

at least one location for storing information about suitability of using at least one of the plurality of products with at least one other of the plurality of products . . . and

an artificial intelligence engine configured to process information reflective of the at least one user-selected product, at least some of the characterizing information, at least some of the suitability information, and at least some of the personal information, and to identify therefrom at least one product complementary to the at least one user-selected product.

As affirmed by the Examiner, *Coleman* does not teach or suggest identifying “at least one product complementary to the at least one user-selected product.” *See* OA at 15. For at least this reason, *Coleman* fails to teach or suggest the “artificial intelligence engine” recited in claim 56.

Furthermore, for at least reasons similar to those presented above in connection with claim 21, *Coleman* does not disclose storing “information about suitability of using at least one of the plurality of products with at least one other of the plurality of products,” as recited in claim 56. The Office Action notes *Coleman*’s disclosure of a “server 104.” Page 2, ¶ 28; OA at 14. *Coleman*’s server, however, does not store information about suitability, as claimed.

Linden does not cure *Coleman*’s deficiencies. Although claim 56 is of different scope than claim 21, *Linden* fails to teach or suggest the “information about suitability” recited in claim

56 for at least reasons similar to those presented above in connection with claim 21.

Additionally, *Linden* fails to teach or suggest the “artificial intelligence engine” recited in claim 56. Although *Linden* mentions identifying items that are either substitutes, tend to be bought in combination, or that are similar in content, the reference does not teach or suggest an artificial intelligence engine configured to “process information reflective of the at least one user-selected product, at least some of the characterizing information, at least some of the suitability information, and at least some of the personal information” to identify therefrom at least one complementary product, as recited in claim 56. Indeed, as explained above in connection with claim 21, *Linden* does not even disclose or suggest processing information characterizing beauty products and suitability information to identify a complementary product.

Accordingly, neither *Coleman* nor *Linden*, nor any combination thereof, teaches or suggests each and every feature required by claim 56. As such, *prima facie* obviousness has not been established and the § 103(a) rejection of claim 56 should be withdrawn.

Furthermore, *prima facie* obviousness has not been established with respect to claim 56 because the required motivation for modifying *Coleman* in view of *Linden* is lacking. The requisite motivation is lacking for at least reasons similar to those presented above in connection with claim 24. Because *prima facie* obviousness has not been established, the § 103(a) rejection of claim 56 should be withdrawn. The rejection of dependent claims 57-59 and 61-68 should be withdrawn as well, for at least reasons similar to those presented in connection with claim 56. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 56-59 and 61-68.

Independent claim 69 recites, *inter alia*:

accessing through the artificial intelligence search engine information about relationships between at least some of the plurality of products; [and]

identifying, by the artificial intelligence engine, a second recommended product complementary to the first product based on at least the information about relationships.

Although claim 69 is of different scope than claim 24, a case for *prima facie* obviousness is lacking with respect to claim 69 for at least reasons similar to those presented above in connection with claim 24. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claim 69.

X. Section 103(a) rejection of claims 28-35, 70-79 and 81-86

Applicants traverse the rejection of claims 28-35, 70-79 and 81-86 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Coleman, Linden, and Lambertsen*.

Claims 28-35 ultimately depend from base claim 24. For at least the reasons presented above in connection with claim 24, *prima facie* obviousness has not been established with respect to claims 28-35 based on *Coleman and Linden*.

Moreover, a case for *prima facie* obviousness has not been established based on *Coleman, Linden, and Lambertsen*, since the requisite motivation for combining these references is lacking. The requisite motivation is lacking for at least the reasons presented above in connection with claim 24. Further, the Examiner's additional allegations set forth in the rejection of claim 28 (OA at 20) do not establish that Applicants' claimed invention, as a whole, would have been obvious. The Office Action does not show that the cited art "suggests the desirability" of the alleged modification, and Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For at

least these reasons, *prima facie* obviousness has not been established and the § 103(a) rejection of claims 28-35 should be withdrawn.

Additionally, with regard to claim 30, neither *Coleman*, *Linden*, nor *Lambertsen*, nor any combination thereof, teaches or suggests at least “wherein the user-specified product is at least two products, and wherein during identifying, the artificial intelligence engine identifies at least one product complementary to a combination of the at least two user-specified products,” as claimed. For reasons similar to those presented above in connection with claim 21, *Coleman* does not teach or suggest the identifying “at least one product complementary to a combination of the at least two user-specified products,” as claimed. In fact, as the Examiner conceded, *Coleman* does not even teach or suggest identifying at least one recommended product complementary to at least one user-specified product using at least the information about product relationships. OA at 20. Also, *Linden*’s system merely identifies items related to a particular item of interest. *Linden* does not teach or suggest identifying an additional product that is “complementary to a combination of the at least two user-specified products,” as claimed. Moreover, *Lambertsen* fails to teach or suggest identifying “at least one product complementary to a combination of the at least two user-specified products” using at least information about product relationships, as claimed. *Lambertsen* merely discloses product palettes that are pre-configured or created by a user from a list of available products (page 3, ¶ 29). Because the applied references, taken alone or in combination, fail to teach or suggest each and every feature of claim 30, the § 103(a) rejection of that claim should be withdrawn.

Independent claim 70 recites a combination including:

selecting at least one second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product;
and

enabling a display of a simulation of the first and second beauty products applied on the facial image.

Neither *Coleman* nor *Linden*, nor any combination thereof, teaches or suggests at least “enabling a display of a simulation of the first [beauty product] and second beauty [product selected as complementary to the first product] applied on the facial image,” as claimed. Indeed, the Examiner explicitly concedes that *Coleman* lacks this feature and appears to concede the same with respect to *Linden*. OA at 23.

In an attempt to establish *prima facie* obviousness, the Examiner alleged that *Lambertsen* teaches the claimed “enabling a display.” Applicants disagree with the Examiner’s interpretation of *Lambertsen*. *Lambertsen* discloses beauty product palettes that are pre-configured or created by a user from a list of available products (page 3, ¶ 29). Although *Lambertsen* discloses that products included in a palette may be used for a makeover and applied to a computer image, *Lambertsen* does not disclose enabling a display on an image of a simulation of a first beauty product from the palette and a second beauty product from the palette, where the second beauty product is selected as complementary to the first product based on information reflecting a relationship between the first beauty product and the second beauty product. Applicants point out that “[a]scertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.” M.P.E.P. § 2141.02. *Lambertsen*’s mere disclosure of applying products to a computer image does not constitute the claimed “enabling a display,” when this feature is viewed as within the whole of claim 70. Specifically, when the “first and second beauty products” included in the “enabling a display” feature are viewed as part of the whole of claim 70 (e.g., that the second beauty product is a selected complementary product), *Lambertsen* does not teach or suggest the “enabling a display” feature. Because neither *Coleman*, *Linden*, nor *Lambertsen*,

nor any combination thereof, teaches or suggests each and every feature of claim 70, the § 103(a) rejection of that claim should be withdrawn.

In addition, *prima facie* obviousness has not been established with respect to claim 70 at least because the requisite motivation to modify *Coleman* in view of *Linden* and *Lambertsen* is lacking. The Examiner alleged that a skilled artisan would have modified *Lambertsen* “for the purpose of determining product relatedness and accentuating a user’s natural features.” OA at 24. This allegation in the Office Action, however, does not establish that a skilled artisan would have performed the alleged modification. While alleging that the cited art discloses certain elements, the Office Action does not establish, by clear and particular evidence, that a skilled artisan would have selected or modified those elements in the manner claimed and that the claimed invention as a whole would have been obvious. Further, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For at least these additional reasons, the § 103(a) rejection of claim 70 should be withdrawn.

Claims 71-79 and 81-86 depend (directly or indirectly) from claim 70. The rejection of claims 71-79 and 81-86 should be withdrawn for at least reasons similar to those presented above in connection with claim 70. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 70-79 and 81-86.

XI. Section 103(a) rejection of claims 13, 42-44 and 47-51

Applicants traverse the rejection of claims 13, 42-44 and 47-51 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Dooley*, *Saita*, and *Coleman*.

Claim 13 depends from claim 1. *Dooley* does not teach or suggest each and every feature of dependent claim 13, which includes all of the features of claim 1. For example, as explained above, *Dooley* does not teach or suggest at least the “accessing” and “identifying” recited in claim 1 and required by claim 13. Moreover, as affirmed by the Examiner (OA at 26) *Dooley* does not disclose that “the information reflecting relationships is derived by surveying at least one of consumer preferences and consumer habits,” as recited in claim 13.

Saita does not cure *Dooley*’s deficiencies. As explained above, although *Saita* mentions subject preferences, the reference does not teach or suggest the claimed “accessing.” *Saita* further fails to teach or suggest the claimed “identifying.”

Coleman does not cure the deficiencies of *Dooley* and *Saita* deficiencies. *Coleman* does not disclose at least the “accessing” recited in claim 1 and required by claim 13. *Coleman* describes a FLE that can “evaluate . . . user requirements against available products or services to generate product or service recommendations most closely matching the user requirements” (page 6, ¶ 57). *Coleman* describes a database that stores products and product information (page 9, ¶ 82). According to *Coleman*, the database includes product criteria (e.g., size, etc.), questions associated with the criteria, options for the criteria, controls for selecting the options, selection guidance for the options, and links to other criteria (page 9, ¶ 82). This information does not constitute information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice, as claimed. Indeed, *Coleman* does not disclose “accessing a data structure containing information reflecting relationships . . .” as claimed.

In addition, contrary to the Examiner’s allegations, *Coleman* does not teach or suggest that “the information reflecting relationships is derived by surveying at least one of consumer

preferences and consumer habits,” as recited in claim 13. *Coleman*’s disclosure regarding users surveying different options to gather information about a product before requesting to view all of the identified products and classifying product selections (page 7, ¶ 59) does not teach or suggest that data reflecting relationships between categories of user-specific information and beauty advice is derived by surveying at least one of consumer preferences and consumer habits, as claimed. *See* OA at 26.

Accordingly, neither *Dooley*, *Saita*, nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature required by claim 13. Because the applied references do not teach or suggest each and every claimed feature, the § 103(a) rejection of claim 13 should be withdrawn.

Furthermore, *prima facie* obviousness has not been established with respect to claim 13 because the required motivation for modifying *Dooley* in view of *Saita* and *Coleman* is lacking. As explained above in connection with claim 1, the requisite motivation to modify *Dooley* in view of *Saita* is lacking. Additionally, the Office Action has not shown that a skilled artisan would have been motivated to modify *Dooley* in view of *Saita* in further view of *Coleman* in a manner resulting in Applicants’ claimed combination. The Examiner alleges that a skilled artisan would have modified *Dooley* in view of *Saita* and *Coleman* “for the purpose of creating a simulated image of the subject and providing valuable guidance.” OA at 28. This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Dooley* as alleged. The Office Action does not show that the cited art “suggests the desirability” of the alleged modification. For example, the Examiner does not articulate what or how “valuable guidance” would be provided.

Applicants again call attention to M.P.E.P. § 2141.02, which states: “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). In addition, Applicants again note that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). In this case, the Examiner merely alleged that *Dooley*, *Saita*, and *Coleman* disclose certain elements, without showing reasons why a skilled artisan would select or modify those elements in the manner claimed and also without showing that the claimed invention as a whole would have been obvious. Furthermore, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For at least these additional reasons, a *prima facie* case of obviousness has not been established with respect to claim 13.

Because *prima facie* obviousness has not been established, the rejection of claim 13 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claim 13.

Each of claims 42-44 and 47-51 depends (directly or indirectly) from base claim 36. *Dooley* does not teach or suggest each and every feature of dependent claims 42-44 and 47-51, each of which includes all of the features of claim 36. For example, as explained above, *Dooley* fails to teach or suggest “a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relations

derived from at least one of consumer preferences and expert advice,” as claimed. *Dooley* further fails to teach or suggest the claimed “artificial intelligence engine.”

As explained above in connection with claim 36, *Saita* does not cure *Dooley*’s deficiencies. Moreover, *Coleman* does not cure the deficiencies of *Dooley* and *Saita*. For reasons similar to those noted above in connection with claim 13, *Coleman* does not teach or suggest at least “a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice,” as recited in claim 36 and required by each of claims 42-44 and 47-51. In addition, for reasons similar to those presented above in connection with claim 13, *Coleman* fails to teach or suggest that “the information reflecting relationships is derived by surveying at least one of consumer preferences and consumer habits,” as required by dependent claim 48. Accordingly, neither *Dooley*, *Saita*, nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature required by claims 42-44 and 47-51. For at least this reason, the § 103(a) rejection of claims 42-44 and 47-51 should be withdrawn.

In addition, regarding claims 42-44 and 47-51, the requisite motivation for modifying *Dooley* in view of *Saita* and *Coleman* is lacking. Again, the Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Saita* and *Coleman* “for the purpose of creating a simulated image of the subject and providing valuable guidance.” OA at 30. For reasons similar to those presented above in connection with claim 13, the required motivation has not been established with respect to claims 42-44 and 47-51. For these additional reasons, the § 103(a) rejection of claims 42-44 and 47-51 should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of these claims.

XII. Section 103(a) rejection of claims 45 and 46

Applicants traverse the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Dooley*, *Saita*, *Coleman*, and *Lambertsen*.

Claims 45 and 46 ultimately depend upon claim 36. As explained above in connection with claims 42-44 and 47-51, neither *Dooley*, *Saita*, nor *Coleman* teaches or suggests each and every feature of claim 36. These references therefore fail to teach or suggest each and every feature of claims 45 and 46, each of which includes all of the features of claim 36.

Lambertsen fails to cure the deficiencies of *Dooley*, *Saita*, and *Coleman*. *Lambertsen* describes a virtual makeover system. *Lambertsen* fails to teach or suggest at least “a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice,” which is missing from *Dooley*, *Saita*, and *Coleman* but recited in claim 36 and required by both claims 45 and 46. Accordingly, neither *Dooley*, *Saita*, *Coleman* nor *Lambertsen*, nor any combination thereof, teaches or suggests each and every element recited in claims 45 and 46. As such, *prima facie* obviousness has not been established and the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) should be withdrawn.

Further, the requisite motivation for modifying *Dooley* in view of *Saita*, *Coleman* and *Lambertsen* is lacking. The Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Saita*, *Coleman* and *Lambertsen* “for the purpose of creating a simulated image of the subject, providing valuable guidance and accentuating a user’s natural features.” OA at 34. The required motivation has not been established for reasons similar to those presented above in connection with claims 13, 42-44 and 47-51. The Examiner, again, merely alleged that the

applied references disclose certain elements, without showing reasons why a skilled artisan would select or modify those elements in the manner claimed and also without showing that the claimed invention as a whole would have been obvious. Furthermore, Applicants submit that teachings of the present application were improperly used to reconstruct the prior art. For at least these additional reasons, the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claims 45 and 46 and the timely allowance of these claims.

XIII. Section 103(a) rejection of claims 17-19 and 52-54

Applicants traverse the rejection of claims 17-19 and 52-54 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Dooley*, *Saita*, and *Lambertsen*.

Claims 17-19 depend from claim 1. For the reasons presented above, neither *Dooley* nor *Saita*, nor any combination thereof, teaches or suggests each and every feature of claim 1. *Dooley* and *Saita*, whether taken alone or in combination, therefore fail to teach or suggest each and every feature of claims 17-19, each of which includes all of the features of claim 1.

Lambertsen fails to cure the deficiencies of *Dooley*. *Lambertsen*, which is directed to a virtual makeover system, does not teach or suggest at least the “accessing” and “identifying” required by dependent claims 17-19 but missing from *Dooley* and *Saita*. Accordingly, neither *Dooley*, *Saita*, nor *Lambertsen*, nor any combination thereof, teaches or suggest each and every feature recited in claim 1 and required by each of claims 17-19.

Further, with regard to claim 17, neither *Dooley*, *Saita*, nor *Lambertsen* teaches or suggests that “the accessed data structure includes information characterizing a plurality of

beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products,” as claimed. The Examiner notes *Lambertsen*’s disclosure of a product catalog and palette database (page 1, ¶ 8). Contrary to the Examiner’s position, however, a catalog of a variety of beauty products does not teach or suggest information characterizing a plurality of beauty products and information about suitability of combining products. Further, a palette of beauty products that create a makeover does not teach or suggest information characterizing a plurality of beauty products and information about suitability of combining products. Although *Lambertsen*’s palettes include products that may be combined, *Lambertsen* does not disclose accessing a data structure that includes information characterizing beauty products and information about suitability of combining beauty products. *Lambertsen* merely discloses that the palettes are pre-configured or created by a user from a list of available products (page 3, ¶ 29).

In addition, with regard to claim 19, neither *Dooley*, *Saita*, nor *Lambertsen* teaches or suggests that “information characterizing a plurality of beauty products includes information about inter-product compatibility,” as claimed. Because the applied references, taken alone or in combination, do not teach or suggest each and every claimed element, *prima facie* obviousness has not been established with respect to claims 17-19.

Moreover, *prima facie* obviousness has not been established with respect to claims 17-19 at least because the requisite motivation for modifying *Dooley* in view of *Saita* and *Lambertsen* is lacking. The Examiner alleged that a skilled artisan would have modified *Dooley* “for the purpose of creating a simulated image of the subject and accentuating a user’s natural features.” OA at 36. For at least reasons similar to those presented above in connection with claims 13 and 42-51, the requisite motivation is lacking. Indeed, the Examiner has not shown that a skilled

artisan considering *Dooley*, *Saita*, and *Lambertsen*, and not having the benefit of Applicants' disclosure, would have been motivated to modify *Dooley* in a manner resulting in Applicants' claimed combination. For at least these additional reasons, *prima facie* obviousness has not been established and the § 103(a) rejection of claims 17-19 should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of these claims.

Claims 52-54 depend from base claim 36. As explained above, neither *Dooley* nor *Saita*, nor any combination thereof, teaches or suggests each and every feature of claim 36. These references therefore fail to teach or suggest each and every feature of claims 52-54, each of which includes all of the features of claim 36. In addition, *Lambertsen* fails to cure the deficiencies of *Dooley* and *Saita*. *Lambertsen* does not teach or suggest at least the "data structure" and "artificial intelligence engine," which are missing from *Dooley* and *Saita* but recited in claim 36 and required by each of claims 52-54.

Further, for reasons similar to those presented above in connection with claim 17, neither *Dooley*, *Saita*, nor *Lambertsen* teaches or suggests that "the data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products," as recited in claim 52. For the reasons noted above in connection with claim 19, *Dooley*, *Saita*, and *Lambertsen* also fail to teach or suggest that "information characterizing a plurality of beauty products includes information about inter-product compatibility," as recited in claim 54. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claims 52-54 and the § 103(a) rejection should therefore be withdrawn.

Moreover, for at least reasons similar to those presented above in connection with claims 17-19, the requisite motivation for modifying *Dooley* in view of *Saita* and *Lambertsen* is lacking. For thus additional reason, the § 103(a) rejection of claims 52-54 should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of these claims.

XIV. Section 103(a) rejection of claims 20 and 55

Applicants traverse the rejection of claims 20 and 55 under 35 U.S.C. § 103(a) because *prima facie* obviousness has not been established based on *Dooley*, *Saita*, *Lambertsen*, and *Coleman*.

Claim 20 depends from claim 17, which in turn depends from claim 1. *Dooley*, *Saita*, and *Lambertsen* fail to teach or suggest each and every feature of claim 20, which includes all of the features of claims 1 and 17. As explained above in connection with claim 17, neither *Dooley*, *Saita*, nor *Lambertsen*, nor any combination thereof, teaches or suggests at least the “accessing” and “identifying” recited in claim 1. In addition, as noted above, neither *Dooley*, *Saita*, nor *Lambertsen* teaches or suggests that “the accessed data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products,” as recited in claim 17.

Coleman fails to cure the deficiencies of *Dooley*, *Saita*, and *Lambertsen*. For example, as noted above (*see, e.g.,* claim 13), *Coleman* does not disclose the claimed “accessing.” In addition, *Coleman* does not disclose the elements added by dependent claims 17 and 20. Because the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claim 20, the § 103(a) rejection should be withdrawn. In addition, the

§ 103(a) rejection should be withdrawn because the requisite motivation for modifying *Dooley* in view of *Saita*, *Lambertsen*, and *Coleman* is lacking. The allegations relating to motivation in the Office Action are not properly supported and do not establish that Applicants' claimed invention, as a whole, would have been obvious. For at least these reasons, Applicants request withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a) and the timely allowance of that claim.

Claim 55 depends from claim 52, which in turn depends from claim 36. As explained above in connection with claim 52, neither *Dooley*, *Saita*, nor *Lambertsen*, nor any combination thereof, teaches or suggests at least the "data structure" and "artificial intelligence engine" recited in claim 36. In addition, as noted above, neither *Dooley*, *Saita*, nor *Lambertsen* teaches or suggests that "the data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products," as recited in claim 52. *Dooley*, *Saita*, and *Lambertsen* therefore fail to teach or suggest each and every feature of claim 55, which includes all of the features of claims 36 and 52.

Coleman fails to cure the deficiencies of *Dooley*, *Saita*, and *Lambertsen*. For example, (for reasons similar to those presented above in connection with claims 13) *Coleman* does not disclose the claimed "data structure." *Coleman* also appears to lack disclosure of the elements added by dependent claims 52 and 55. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claim 55 and, thus, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn. In addition, the § 103(a) rejection should be withdrawn because the requisite motivation for modifying *Dooley* in view of *Lambertsen*, *Saita*, and *Coleman* is lacking. The allegations relating to motivation in the Office Action are not properly supported and do not establish that Applicants' claimed invention, as a

whole, would have been obvious. For at least these reasons, Applicants request withdrawal of the rejection of claim 55 under 35 U.S.C. § 103(a) and the timely allowance of that claim.

XV. Section 103(a) rejection of claim 60

Applicants traverse the rejection of claim 60 under 35 U.S.C. § 103(a) because *prima facie* obviousness has not been established based on *Coleman*, *Linden*, and *Dooley*.

Claim 60 depends upon claim 56. As explained above, neither *Coleman* nor *Linden*, nor any combination thereof, teaches or suggests at least the following features of claim 56:

at least one location for storing information about suitability of using at least one of the plurality of products with at least one other of the plurality of products . . . and

an artificial intelligence engine configured to process information reflective of the at least one user-selected product, at least some of the characterizing information, at least some of the suitability information, and at least some of the personal information, and to identify therefrom at least one product complementary to the at least one user-selected product.

Coleman and *Linden*, taken alone or in combination, therefore fail to teach or suggest each and every feature of claim 60, which includes all of the features of claim 56.

Dooley fails to cure the deficiencies of *Coleman* and *Linden*. *Dooley*, which describes an Internet-based information network, does not disclose or suggest the claimed “location for storing information about suitability of using at least one [product] . . . with at least one other [product] . . .” or the claimed “artificial intelligence engine.” Accordingly, neither *Coleman*, *Linden*, nor *Dooley*, nor any combination thereof, teaches or suggests each and every element recited in claim 56 and required by claim 60. For at least this reason, the rejection of claim 60 under 35 U.S.C. § 103(a) should be withdrawn.

Furthermore, the § 103(a) rejection of claim 60 should be withdrawn at least because the requisite motivation for modifying *Coleman* in view of *Linden* and *Dooley* is lacking. The

Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Lambertsen* “for the purpose of determining product relatedness and increasing traffic.” OA at 41. This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Coleman* as alleged. The Office Action alleged that *Coleman*, *Linden*, and *Dooley* disclose certain elements, but fails to show that a skilled artisan would select or modify those allegedly disclosed elements in the manner claimed and fails equally to show that the claimed invention as a whole would have been obvious. Applicants further submit that the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the prior art. For these additional reasons, the § 103(a) rejection of claim 60 should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of that pending claim.

XVI. Section 103(a) rejection of claim 80

Applicants traverse the rejection of claim 80 under 35 U.S.C. § 103(a) for at least the following reasons.

Claim 80 depends upon claim 70. For the reasons noted above, neither *Coleman*, *Linden*, nor *Lambertsen*, nor any combination thereof, teaches or suggests “enabling a display of a simulation of the first and second beauty products applied on the facial image,” as recited in claim 70. These references, taken alone or in combination, therefore fail to teach or suggest each and every feature of claim 80, which includes all of the features of claim 70.

Horikita does not cure the deficiencies of *Coleman*, *Linden*, and *Lambertsen*. *Horikita* is directed to a make-up simulator. *Horikita* does not teach or suggest at least “enabling a display of a simulation of the first [beauty product] and second beauty . . . [product complementary to

the first beauty product] applied on the facial image,” as required by claim 80 due to its dependency from claim 70.

Marapane does not cure the deficiencies of *Coleman*, *Linden*, *Lambertsen* and *Horikita*. *Marapane* describes a system for analyzing hair. *Marapane* discloses predicting achievable hair colors for users and recommending color agents based on those achievable colors selected by the users (Figs. 1, 12; col. 3, line 9 – col. 4, line 45). Although *Marapane* mentions product recommendations, it does not teach or suggest “enabling a display of a simulation of the first [beauty product] and second beauty . . . [product complementary to the first beauty product] applied on the facial image,” as required by claim 80.

Accordingly, neither *Coleman*, *Linden*, *Lambertsen*, *Horikita* nor *Marapane*, nor any combination thereof, teaches or suggests the “enabling a display . . .” recited in claim 70 and required by dependent claim 80. Because the applied references, taken alone or in combination, do not teach or suggest each and every element required by claim 80, the § 103(a) rejection of that claim should be withdrawn.

In addition, the § 103(a) rejection of claim 80 should be withdrawn at least because the requisite motivation for modifying *Coleman* in view of *Linden*, *Lambertsen*, *Horikita* and *Marapane* is lacking. The Examiner alleged that a skilled artisan would have modified *Coleman* “for the purpose of determining product relatedness, accentuating a user’s natural features, improved processing and accounting for lighting differences.” OA at 44. This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Coleman* as alleged. For example, the Examiner provides no evidence or reasoning to show how the alleged modification would in fact achieve the alleged results, or to show that a skilled artisan would even be concerned with achieving those results. The Examiner also fails to

articulate a basis for evaluating “improved processing.” In attempting to establish a motivation, the Examiner notes *Lambertsen*’s alleged disclosure of “[a]ccentuating . . . user’s features.” OA at 44. The Examiner also notes *Horikita*’s alleged disclosure of “[i]mproved operability and processing” and *Marapane*’s disclosure of “[a]ccounting for lighting differences.” These disclosures do not establish that a skilled artisan would have modified *Coleman* as alleged. While alleging that the cited art disclose certain elements, the Office Action does not establish that a skilled artisan would select or modify those elements in the manner claimed and does not establish that Applicants’ claimed invention as a whole would have been obvious. Again, Applicants’ claims appear to have been improperly used to reconstruct the prior art. For these additional reasons, the rejection of claim 80 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of that claim.

XVII. New claims 87-91

New claims 87-89 depend upon independent claim 21, and new claims 90 and 91 depend upon independent claim 24. Applicants submit that new claims 87-91 should be allowed for at least reasons similar to those presented above in connection with their base claims 21 and 24, respectively. Further, Applicants submit that the applied references, taken alone or in combination, fail to teach or suggest various features recited in new claims 87-91.

XVIII. Conclusion

The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner’s reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 15, 2005

By: _____


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